



# UNITED STATES PATENT AND TRADEMARK OFFICE

54

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,363	01/26/2001	Yoshihiro Ishida	35.G2725	4785

5514 7590 05/04/2005

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

PHAM, THIERRY L

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/769,363

Applicant(s)

ISHIDA ET AL

Examiner

Thierry L Pham

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 12/7/2004.
- Claims 1-23 are pending in application.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (U.S. 5621810), and in view of Fukushima et al (U.S. 5465172).

Regarding claim 1, Suzuki discloses an image processing apparatus (copy machine, fig. 2) comprising:

- image-data input means (image scanner 201, fig. 2, col. 4, lines 1-20) for inputting image data;
- specific-image determination means (prohibition pattern detection means, fig. 36, col. 2, lines 1-50 and col. 4, lines 36-64) for determining whether the image data inputted by said image-data input means represents a specific image having predetermined characteristics (i.e. digital watermark, figs. 14-15).

However, Suzuki does not expressly disclose (1) re-input determination means for determining whether to output a signal urging re-input of the image data input by said image-data input means; and (2) signal output means for outputting the signal urging re-input of the image data, in accordance with a result of the determination by said re-input determination means, in accordance with a difficulty of determining whether the image data represents a specific image.

Fukushima, in the same field of endeavor for image processing apparatus, discloses (1) re-input determination means (re-reading if first reading is abnormal, abstract and col. 2, lines 20-56) for determining whether to output a signal urging re-input of the image data input by said image-data input means; and (2) signal output means (detector means for detecting errors in

Art Unit: 2624

reading/scanning originals and outputting a signal to re-read or re-scan the original if errors occur, abstract and col. 2, lines 20-56) for outputting the signal urging re-input of the image data, in accordance with a result of the determination by said re-input determination means. In addition, Suzuki also discloses a security pattern (i.e. digital watermark) within the original can be detected regardless of how an original is placed on the platen (arbitrary positioning of the originals, col. 2, lines 1-32 and col. 10, lines 1-40 and col. 11, lines 8-34) without having to re-input and/or re-scan of the originals.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Suzuki as per teachings of Fukushima because of a following reason: (1) to accurately prevent forgery of security marks/originals (Suzuki, col. 2, lines 20-32); (2) to increase operating efficiency by automatically re-scan originals without operator intervention/interface (Fukushima, col. 1, lines 45-52).

Therefore, it would have been obvious to combine Suzuki with Fukushima to obtain the invention as specified in claim 1.

Regarding claim 2, Suzuki further discloses an image processing apparatus according to claim 1, wherein said specific-image determination means determines whether the image data obtained from said image-data input means represents a copy-prohibition image (i.e. money, fig. 14a).

Regarding claim 3, Suzuki further discloses an image processing apparatus according to claim 1, wherein said re-input determination means determines whether re-input of image data is to be urged, by determining difficulty (pattern matching determination means by determining position of protected-pattern with respect to position of the original, col. 2, lines 1-50 and col. 9, lines 18-65) in determination whether the image data represents the specific image.

Regarding claim 4, Suzuki further discloses an image processing apparatus according to claim 2, wherein said re-input determination means determines whether re-input of image data is to be urged by determining difficulty (pattern matching determination means by determining

Art Unit: 2624

position of protected-pattern with respect to position of the original, col. 2, lines 1-50 and col. 9, lines 18-65) in determination whether the image data represents a copy-prohibition image.

Regarding claim 5, Suzuki further discloses an image processing apparatus according to claim 1, wherein said re-input determination means comprises difficulty calculation means (pattern matching determination means by determining position of protected-pattern with respect to position of the original, col. 2, lines 1-50 and col. 9, lines 18-65) for calculating difficulty in determination whether the image data represents the specific image, and difficulty determination means for determining whether the determination of said specific-image determination means is difficult based on the difficulty calculated by said difficulty calculation means.

Regarding claim 6, Suzuki further discloses an image processing apparatus according to claim 2, wherein said re-input determination means comprises difficulty calculation means for calculating difficulty in determination whether the image data represents a copy-prohibition image, and difficulty determination means (col. 2, lines 1-50 and cols. 9-10) for determining whether the determination whether the image data represents a copy-prohibition image is difficult, based on the difficulty calculated by said difficulty calculation means.

Regarding claim 7, Suzuki further discloses an image processing apparatus according to claim 1, wherein said re-input determination means determines whether the re-input is to be urged, from data based on a position of an original (fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) in an image represented by the input image data.

Regarding claim 8, Suzuki further discloses an image processing apparatus according to claim 5, wherein said difficulty calculation means calculates the difficulty in the determination of the specific image, from data based on a position (fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) of an original in an image represented by the input image data, and wherein said difficulty determination means determines whether the determination by said specific-image determination means is difficult, by comparing data of the difficulty calculated by said difficulty

Art Unit: 2624

calculation means with a predetermined value (comparing to a predetermined threshold value, col. 10, lines 1-67).

Regarding claim 9, Suzuki further discloses an image processing apparatus according to claim 6, wherein said difficulty calculation means calculates the difficulty in the determination of a copy-prohibition image, from data based on a position (position calculation means, fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) of an original in an image represented by the input image data, and wherein said difficulty determination means determines whether the determination of a copy-prohibition image is difficult, by comparing data of the difficulty calculated by said difficulty calculation means with a predetermined value (comparing to a predetermined threshold value, col. 10, lines 1-67).

Regarding claim 10, Suzuki an image processing apparatus according to claim 7, wherein data of difficulty calculated from data based on the position of the original in the image represented by the input image data is an angle (angle calculation means, fig. 1 and fig. 14, col. 2, lines 1-30 and col. 8, lines 10-55) of the original with respect to a scanning direction (fig. 1) of the image represented by the input image data.

Regarding claim 11, Suzuki further discloses an image processing apparatus according to claim 7, wherein data of difficulty calculated from data based on the position of the original in the image represented by the input image data is a deviation (i.e. angular and positional difference, cols. 8-10) of the original from a predetermined position with respect to a scanning direction of the image represented by the input image data.

Regarding claims 12-22: Claims 12-22 are the method claims corresponding to the apparatus claims 1-11. The method claims are included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 1-11 above.

Claim 23 corresponds to claim 1 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers/printers have

Art Unit: 2624

some type of computer readable memory medium (RAM, fig. 4) for storing computer programs; therefore, claim 23 would be rejected using the same rationale as in claim 1.

### ***Response to Arguments***

Applicant's arguments filed 12/7/04 have been fully considered but they are not persuasive.

- Regarding claims 1, 12, and 23, the applicants argued the cited prior arts of record (US 5621810 to Suzuki and US 5465172 to Fukushima) fail to teach and/or suggest the feature of determining whether to output a signal urging re-input of the image data input by the image-data input means, in accordance with a difficulty of determining whether the image data represents a specific image.

In response, the examiner disagrees with the applicants' assertions. Suzuki teaches a copy machine for preventing copying confidential documents (i.e. security banknotes and/or money). Fukushima teaches a facsimile apparatus includes a scanning and printing functions for automatically re-reading/re-scanning originals if the first reading is caused by an error (i.e. difficulty reading the originals). According to the originally filed specification by the applicants, it is difficult to determine whether the image data represents a specific image (i.e. copy-prohibition image) depends upon a mounting angle of the originals; in other words, it is difficult to calculate and to determine if the originals contain copy-prohibited image based upon a mounting angle of the original on the platen of the scanner. For example, if a mounting angle with respect to the platen is zero, then proceeds to calculate and to determine whether the original contains a confidential mark; and if a mounting angle with respect to the platen is greater than zero, a message indicating to an operator to re-position (and to re-input/re-scan) the original so a mounting angle is aligned at a zero degree with respect to platen surface (see figs. 4-6 for details). Fukushima explicitly teaches these features (i.e. automatically re-scanning the originals). In addition, Suzuki also discloses a security pattern (i.e. digital watermark) within the original can be detected regardless of how an original is placed on the platen (arbitrary positioning of the originals as shown in figs. 1, 11, and 14A, col. 2, lines 1-32, col. 10, lines 1-40, and col. 11, lines 8-34) without having to re-input and/or re-scan of the originals. Apparently, Suzuki's patented system has an advantage (i.e. reducing costs) over the applicants'

Art Unit: 2624

proposed disclosure because the confidential marks can be detected/calculated regardless of how the original is placed on the platen of the image scanner without having to re-input and/or re-scan by the operator.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. 6643028 to Ogaki et al, discloses a method for scanning originals and re-scanning originals.
- U.S. 5719968 to Hashimoto, discloses a method for scanning originals and automatically adjusting the originals without having to re-scan and/or re-input the originals.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (571) 2727439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

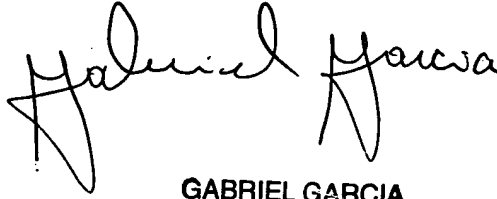
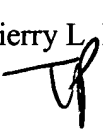
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 2624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA  
PRIMARY EXAMINER